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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,929	03/09/2001	Charles Patrick Thacker	03797.00092	3449

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EXAMINER
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LIU, MING HUN

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/801,929		THACKER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Ming-Hun Liu		2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-7, 9, 25, 26 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 9, 25, 26 and 28-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 7, 9, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,757,002 to Oross et al.

In reference to claim 1, Oross teaches a mouse emulating device displaying a user interface with a plurality of selectable functions. Oross states on column 7, lines 52-54 that the selectable functions can be set to *any* keyboard *key*, *sequence*, or *function*, thus anticipating the limitations outlined in the claim. Oross shows in figure 13 that the controller receives a user selection (step 98) and then sends the event of the selection function (104) - the deceptions of these steps can be found on column 10, lines 55-67.

In reference to claim 4, Oross teaches the step of hiding the interface after the user has selected the function (column 8, line 8-9).

In reference to claim 7, Oross also teaches the method of hiding the display after a certain amount of inactivity time has elapsed (column 8, lines 9-11).

In reference to claim 9, Oross teaches on column 6, lines 1-15 that the functions are pre-programmed executable functions.

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As to claim 31, by referring to figure 1A, it is apparent that the invention is used on computer system.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oross.

In reference to claims 5 and 6, Oross teaches on column 3, lines 39-42 and column 7, lines 43-45), that the specialize selectable functions maybe specific mouse click or clicks. As one skilled in the art understands, the right click is a conventional and often used click function. It would have been obvious to one skilled in the art to incorporate a right click as a selectable function because of its high frequency of use.

5. Claims 1, 9, 32-38, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,018,336 to Akiyama et al.

In reference to independent claims 1 and 32-38, Akiyama teaches a mouse emulating stylus similar to the one being claimed. His invention includes a method that includes receiving a user selection and sending a mouse button even *modified by the selected function* (explicitly stated in column 1, line 60-column 2, line 6 and inferred in the background section: column 1,

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line 38-43). The major difference between the two inventions lies in the particulars of the selectable functions. Akiyama does not explicitly teach that the selectable functions include shift or control function.

However, what Akiyama does do is leave indefinite the particular functions in which the system can emulate. As shown in figure 2, and described in column 2, lines 48-50, "the structure of a hardware and that of a software to emulate a plurality of kinds of mouse functions in the computer system."

As one skilled in the art understands, shift and control buttons are commonly found functions. And as Akiyama alluded in the specifications the function selected are dependent upon the operating system. Windows based systems often use control and shift function and it would have been obvious to one skilled in the art to include such high frequency functions.

Claims 9, 41 and 44, Akiyama shows in figure 1 that hard drive 21, CPU 11, Ram 12 and ROM 13, that executes application 124 (figure 2).

In reference to claims 42 and 43, Akiyama teaches that each mode can be locked or unlock depending on the interaction of the user (column 53-59).

6. Claims 25, 26, 28, 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,018,336 to Akiyama et al in view of US Patent 5,500,935 to Moran.

As disclosed in the rejection of claims 1 and 9 according to Akiyama, Akiyama teaches an invention similar to the one being claimed. In the light of the limitations found in claims 25, 26 and 28, Akiyama's invention once again diverges from the claimed invention. As seen from

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figures 3 and 4, Akiyama teaches a mode selection menu that is static in position location. This is however only a suggested presentation format.

Moran also teaches an invention that is similar to the claimed invention. In the background section of Moran's reference, he describes how a conventional mouse emulation by a stylus menu is revealed or interacted with. Moran teaches on column 1, lines 65-67, "menu function, a visible menu is either located on a specified area of a display or appears near the stylus position when desired (pop-up menu)." As one skilled in the art understands these display options are well known in the art and cannot be considered novel. One skilled in the art would have implemented the pop-up menu display to conserve display real estate or reduce the amount of mouse travel required to invoke the new function mode.

In reference to claim 29, Moran teaches on column 5, lines 62-67 that the selection algorithm includes a step where the menu first must be "called" at a particular user action. Moran's description is however vague, but as one skilled in the art understands that calling up a menu inherently implies that the calling fails if the action is not presented.

In reference to claim 40, Moran on column 6, line 10, describes a step where the menu is removed response to a stylus action.

7. Claims 30 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,018,336 to Akiyama et al in view of US Patent 5,500,935 to Moran and in further view of US Patent 5,625,833 to Levine et al.

As mentioned above, Akiyama and Moran teach inventions that are similar to the one being claimed. Akiyama and Moran however do not teach the use of in-air gestures. The feature

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of incorporating in-air gestures with stylus/tablet input devices has been known to ones skilled in the art. Levine teaches in a patent issued in 1997 that gestures include in-air movements (column 6, lines 29-30). Because of the resistive relation inherent to the tablet surface in which the stylus and tablet input methods are conceived and implemented, in-air gestures are inherent to the stylus art.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,603,053

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ming-Hun Liu



DENNIS-DOON CHOW  
PRIMARY EXAMINER